

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-5, 8-10, 12, 14-23, 26-28, 30, and 32-36 are currently pending. Claims 1, 18, 19, and 36 are currently amended. Claims 37 and 38 are newly added. The changes and additions to the claims do not add new matter and are supported, for example, in the originally filed specification at page 14, line 13 to page 15, line 3, and Figure 2.

In the outstanding Office Action, Claim 18 was rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement; Claim 18 was rejected under 35 U.S.C. §112, second paragraph as being indefinite; Claims 1-5, 8-10, 12, 14-23, 26-28, 30, and 32-36 were rejected under 35 U.S.C. §103(a) as unpatentable over Wilson et. al. (U.S. Patent No. 5, 411, 258, hereafter “Wilson”) in view of Walker et al. (U.S. Patent No.6,001,016, hereafter “Walker”).

With respect to the rejections of Claim 18 under 35 U.S.C. §112, first paragraph and second paragraph, Applicants respectfully submit that the amendment to Claim 18 to remove the means plus function language overcomes these grounds of rejection.

With respect to the rejection of Claim 1 under 35 U.S.C. §103(a), Applicants respectfully submit that the amendment to Claim 1 overcomes this ground of rejection.

Amended Claim 1 recites, *inter alia*,

a decision unit configured to decide a result of the game by using a computer logic before the entry time managed by the time management unit elapses.

Figures 1 and 2 of the Applicants’ disclosure illustrate a non-limiting embodiment of these features. Figure 1 shows a game execution system including a game controller 3 having a server 3A. Figure 2 shows that server 3A has a lottery unit 14 that acts as the decision unit (see page 14, lines 13-15). In the example, the lottery unit 14 can select a winning racehorse

from among racehorses to run in a competitive game before the entry time managed by the time management unit elapses (see page 15, lines 17-22). The lottery unit 14 (the decision unit) decides the outcome of the race by using computer logic because it is part of the processing unit 10 shown in Figure 2 (also see page 14, line 13 to page 15, line 3 of the specification). With this configuration, for example, it is difficult to forecast a winning horse because the winning racehorse is randomly decided (see lines page 15, lines 2-3 of the specification).

Wilson describes an interactive video horse race game. In Wilson, the game involves players placing bets for a simulated horse race based on a video of an actual horse race that was pre-recorded (see col. 1, lines 39-68, and col. 4, lines 7-27). Wilson explicitly states that ***“there is no computer logic determining the outcome of a race.”*** (See col. 4, lines 13-15).

Therefore, Wilson fails to disclose or suggest ***a decision unit configured to decide a result of the game by using a computer logic***, as defined by amended Claim 1.

Here, the device of Wilson cannot produce the effects of Claim 1 because in the game of Wilson, “the outcome of the races is based on the outcome of the original race...the basic information being real and the outcome of that race being also real.” (See col. 4, lines 13-27).

Further, an object of Wilson is to provide an interactive video horse-race game which will simulate a simulcast satellite uplink of an actual horse-race, particularly with respect to betting results, and at least to the extent of the finishing order of the win, place and show horses (see col. 1, lines 39-44). From this object and the other disclosures of Wilson, it is important in Wilson to use an outcome of an actual race in the described game. Accordingly, there would be no motivation to use a computer logic to determine an outcome of a race in the game described by Wilson. Wilson clearly teaches away from such a combination.

"A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the

reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 U.S.P.Q.2d 1461 (Fed. Cir. 1989).

Furthermore, Applicants note that MPEP §2143.01(V) states "[t]he proposed modification cannot render the prior art unsatisfactory for its intended purpose." The intended purpose in Wilson is to simulate a horse-race that has already occurred. In other words, the result is predetermined. In Wilson, modifying the system in Wilson to have a random outcome, rather than the predetermined outcome that is being simulated, would render the system in Wilson unsatisfactory for its intended purpose of simulating an actual horse-race that has previously occurred.

Walker has been considered but fails to remedy the deficiencies of Wilson as discussed above with regards to Claim 1.

Thus, Wilson and Walker cannot be properly combined by a person of ordinary skill in the art to overcome the claimed invention.

Therefore, Claim 1 patentably distinguishes over Wilson and Walker, taken either alone or in combination.

Independent Claim 19 recites features similar to those of Claim 1 as discussed above. Therefore, independent Claims 1 and 19 (and all dependent claims) patentably distinguish over Wilson and Walker, taken either alone or in combination.

Consequently, in light of the above discussion and in view of the present amendment, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

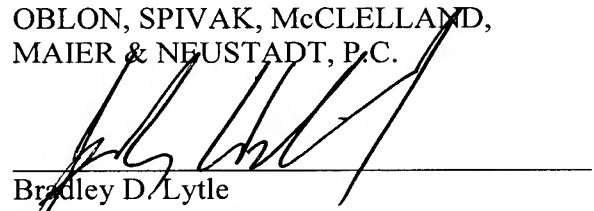
Respectfully submitted,

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